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Remarks

By this amendment, Applicants have amended claims 42 and 43 and added new claims 45–49 to clarify the claims and more particularly set forth the invention. The following claims remain in the present application:

Independent Claims: 1, 13, 25, 34, 42–47

Dependent Claims: 2–12, 14–24, 26–33, 35–41, 48, 49

Re-examination of the present application is requested. No new matter is added by this amendment.

As a preliminary matter, Applicant has amended the specification to correct a typographical error. Applicant submits that no new matter is added by this amendment. Also, Applicant has amended claim 42, which was previously allowed by Examiner, to correct an ambiguity in the number of panels claimed. Applicant submits that this correction adds no new matter and, by the nature of the amendment, that claim 42 is still in condition for allowance.

Applicant respectfully submits that the pending claims patentably distinguish over the cited references. Specifically, Applicant respectfully submits that Morrison in combination with Vaught, fails to disclose or suggest the recited features of the present invention.

To briefly summarize, Morrison is entitled “Adjustable Suspended Overhead Storage Rack.” Morrison discloses hanger supports with hooks on the legs for hooking over rafters, ceiling joists, or the like. See Morrison, FIG. 1. Morrison discloses that planks, separated by the hanger supports, may be used to form a discontinuous surface. See *id.* at FIG. 3.

Vaught is directed to cable hangers for “support[ing] a swinging scaffold below a steel walkway.” See Vaught, col. 1, l. 21. The hangers of Vaught engage the gratings of a steel walkway and include a U-shaped bend that supports a loop of cable. The scaffold is supported by the cable.

Griswold is directed to hanger brackets for suspending a “working scaffold or platform” from I-beam rafters. See Griswold, Abstract. Griswold discloses the use of scissored hangers so that hangers can be mounted around the base of an I-beam, and also so that beams of varying size and shape can be mounted.

Turning first to claim 1, Examiner agrees that in Morrison, “the panels do not form a continuous surface.” Office Action, p. 2. However, Examiner suggests that “Vaught teaches the use of providing a continuous surface as a platform formed of individual panels to be old” and, therefore, combining Morrison and Vaught renders the claimed invention obvious. *Id.* Examiner cites Griswold to support the proposition that such a combination would render the claimed invention obvious. *Id.*

Applicant respectfully submits that Vaught cannot be combined with Morrison (or Griswold) show a continuous surface of individual panels. The reason that Morrison fails to show a continuous surface (as conceded by Examiner) is that Morrison includes hanger supports between planks. That is, the gaps in Morrison exist because Morrison alternates planks with hanger supports. Vaught shows planks forming a scaffold platform. Applicant respectfully submits that Morrison combined with Vaught would still include hanger supports between planks. That is, there is no motivation to convert each individual plank in Morrison to a plurality

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of planks shown in Vaught. As Examiner is aware, a prior art reference (or references when combined) must teach or suggest all the claimed limitations, M.P.E.P. section 2143, and obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion or motivation to do so found *either in the references themselves or in the knowledge generally available to those skilled in the art*. See In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988), M.P.E.P. section 2143.01.

In fact, Morrison teaches away from a combination in which a continuous surface is formed from a plurality of planks. Morrison teaches that each plank is separated from its neighbor by a hanger support. To modify Morrison to include a plurality of planks where Morrison shows only one plank would fundamentally alter Morrison's design. As Examiner is no doubt aware, if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. M.P.E.P. section 2143.01. Therefore, Morrison cannot be combined with, or altered in view of, Vaught to show a continuous surface, uninterrupted by hanger supports, as Examiner suggests because this modification would contradict the express teaching of Morrison of separating planks with supports. Since Morrison cannot be combined with, or modified in view of, Vaught to show a continuous surface, Applicant respectfully submits that claim 1 is allowable.

While not explicitly stated in the Office Action, Applicant respectfully submits that Griswold does not suggest such an alteration either. As argued in Applicant's prior response, when Griswold does use multiple panels, as indicated in FIG. 1 of Griswold, a gap remains.

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While not identified by a reference number, the panel directly above reference number 49 is spaced from panel 40 by the hanger and, thus, does not form a “continuous surface” as claimed. Not only is the surface of Griswold discontinuous because of the gap between the panels, but additionally because of the “step” created by the lap joint of the supporting 4 × 4s. Looking specifically at FIG. 1, the panel supported by the support having reference number 48 is higher than the next panel supported by the support having reference number 49. Consequently, Griswold fails to show or suggest a substantially continuous surface. Griswold himself acknowledges that the lap joint will cause each panel to tilt and suggests adjustments to maintain each panel level (see Griswold, col. 3, ll. 17–25) but Griswold never addresses the step or the gap created at each panel edge. Therefore, Griswold never even suggests that his invention could be altered or modified to form a continuous surface.

These arguments support the patentability of claims 13, 25, and 34 with equal force. The intervening dependent claims, claims 2–12, 14–24, 26–33, and 35–41 are allowable as depending from allowable dependent claims.

Examiner indicated that claim 43 was allowed. Applicant has amended claim 43 to eliminate a redundancy in the claim language. Applicant respectfully submits that amended claim 43 is allowable.

Applicant has added new claim 45–49 to more particularly set forth the present invention. Applicant respectfully submits that the cited references fail to show the features recited in new claims 45–49. Therefore, new claims 45–49 are allowable.

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In summary, Applicant respectfully submits that Examiner's statement that Morrison can be altered in view of Vaught to show a continuous surface formed from individual panels is incorrect. Morrison shows a discontinuous surface in which each panel is separated from its neighbor by a hanger support. To modify Morrison in view of Vaught would still require separation between the panels for the hanger supports. In this regard, Morrison teaches away from a continuous platform and, thus, could not be combined with Vaught. Therefore, Applicant submits that the claims are allowable over the cited art.

Conclusion

For the reasons advanced above, all pending claims are now believed to be in condition for allowance. Should Examiner believe that a telephone interview would advance the prosecution of this application, the undersigned would invite and request such an interview.

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Respectfully submitted,
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